



PATENT

Attorney Docket No. A-67229-13

Dorsey File No. 463077-00245

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re application of:

DAHIYAT et al.

Serial No.: 10/665,307

Filing Date: September 18, 2003

For: *Protein Design Automation for
Protein Libraries*

Examiner: Wessendorf, Teresa D.

Art Unit: 1639

CERTIFICATE OF MAILING

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Dated: 9/24/04

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Jessica L. Newlin

**INFORMATION DISCLOSURE STATEMENT
AND
STATEMENT OF RELATEDNESS**

Commissioner for Patents
P. O. Box 1450
Alexandria, VA 22313-1450

Sir:

In satisfaction of the duty of disclosure under 37 C.F.R. § 1.56, and in accordance with the provisions of 37 C.F.R. §§ 1.97 and 1.98, Applicants wish to draw the attention of the U.S. Patent and Trademark Office to the references cited on the accompanying form PTO/SB/08A-B, Substitute for form PTO 1449. This application is a divisional of U.S. Application Serial No. 09/782,004, filed February 12, 2001 (pending). The references cited on the accompanying form PTO/SB/08A-B, Substitute for form PTO-1449, not marked with an asterisk (*), were previously disclosed in the above-mentioned application and in accordance with 37 C.F.R. § 1.98(d), no copies of these references are enclosed.

Serial No.: 10/665,307
Filing Date: September 18, 2003

Further, in accordance with 1273 Off. Gaz. Pat. Off. 1, 8/5/2003, no copies of U.S. patents and U.S. published applications are enclosed. Copies of all other references are enclosed.

With respect to patent applications, the applicants point out their duty under M.P.E.P. §2001.06(b) to disclose relevant patent applications of which they are aware. To this end, the applicants draw the Examiner's attention to the following patent application:

1. U.S.S.N. 10/888,748, filed July 9, 2004.

Nothing herein shall constitute an admission concerning the contents of any of the cited references, nor shall the inclusion of a reference herein be considered an admission that the reference constitutes prior art against the invention claimed in the above-identified application. Submission of the present document shall not be construed as an admission that a search has been made or that better art does not exist.

Pursuant to 37 C.F.R. § 1.97(c), enclosed is a check in the amount of \$180.00 as set forth in 37 C.F.R. § 1.17(p). While no further fee is believed to be due, if this belief is in error, the Commissioner is authorized to charge any additional fees which may be required, or credit any overpayment to Deposit Account No. 50-2319 (Our Order No. 463077-00245 (A-67229-13/RFT/RMS/RMK)).

The PTO did not receive the following
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Serial No.: 10/665,307
Filing Date: September 18, 2003

Please direct any calls in connection with this application to the undersigned at
(415) 781-1989.

Respectfully submitted,
DORSEY & WHITNEY LLP

Dated: 9/24/04
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Robin M. Silva, Reg. No. 38,304

Customer Number: 32940

Attachments:

Form PTO/SB/08A-B, Substitute for form PTO 1449
3 references

INFORMATION DISCLOSURE STATEMENT BY APPLICANT

(use as many sheets as necessary)

Complete if Known

Application Number 10/665,307
Filing Date September 18, 2003
First Named Inventor DAHIYAT, Bassil I.
Art Unit 1639
Examiner Name Wessendorf, Teresa D.
Attorney Docket Number A-67229-13

U.S. PATENT DOCUMENTS

Examiner Initials*	Cite No. ¹	U.S. Patent Document Number-Kind Code ² (if known)	Publication Date MM-DD-YYYY	Name of Patentee or Applicant of Cited Document	Pages, Columns, Lines, Where Relevant Passages or Relevant Figures Appear
	A1	4,939,666	07-03-1990	Hardman	
	A2	5,241,470	08-31-1993	Lee et al.	
	A3	5,265,030	11-23-1993	Skolnick et al.	
	A4	5,527,681	06-18-1996	Holmes	
	A5	5,878,373	03-02-1999	Cohen et al.	
	A6	6,188,965 B1	02-13-2001	Mayo et al.	
	A7	6,269,312 B1	07-31-2001	Mayo et al.	
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	A9 *	6,708,120 B1	03-16-2004	Mayo et al.	
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	A14 *	2002-0090648 A1	07-11-2002	Dahiyat et al.	
	A15 *	2002-0106694 A1	08-08-2002	Mayo et al.	
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FOREIGN PATENT DOCUMENTS

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	B1 *	EP 0 974 111 B1	01-26-2000	California Institute of Technology		
	B2	WO 95/22625 A1	08-24-1995	Affymax Technologies N.V.		
	B3	WO 98/32845 A1	07-30-1998	Bioinvent International AB		
	B4	WO 98/47089 A1	10-22-1998	California Institute of Technology		
	B5	WO 00/23564 A2	04-27-2000	Xencor, Inc.		
	B6	WO 00/68396 A2, A3	11-16-2000	Xencor, Inc.		
	B7 *	WO 01/59066 A2, A3	08-16-2001	Xencor, Inc.		
	B8 *	WO 03/014325 A2, A3	02-20-2003	Xencor		

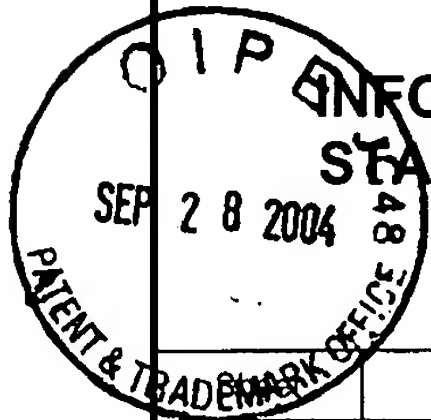
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INFORMATION DISCLOSURE STATEMENT BY APPLICANT

(use as many sheets as necessary)

2 of 5

Complete if Known

Application Number	10/665,307
Filing Date	September 18, 2003
First Named Inventor	DAHIYAT, Bassil I.
Art Unit	1639
Examiner Name	Wessendorf, Teresa D.
Attorney Docket Number	A-67229-13

NON PATENT LITERATURE DOCUMENTS

Examiner Initials*	Cite No.	Include name of the author (in CAPITAL LETTERS), title of the article (when appropriate), title of the item (book, magazine, journal, serial, symposium, catalog, etc.), date, page(s), volume-issue number(s), publisher, city and/or country where published.	T ⁶
	C1	BORMAN, "Proteins to Order," C&EN, 1997, pp.9-10.	
	C2	BOWIE et al., "A Method to Identify Protein Sequences That Fold into a Known Three-Dimensional Structure," Science, 1991, 253(5016):164-170.	
	C3	BOWIE et al., "Deciphering the Message in Protein Sequences: Tolerance to Amino Acid Substitutions," Science, 1990, 247:1306-1310.	
	C4	BRENNER et al., "A quantitative methodology for the de novo design of proteins," Protein Science, 1994, 3:1871-1882.	
	C5	BROOKS et al., "CHARMM: A Program for Macromolecular Energy, Minimization, and Dynamics Calculations," Journal of Computational Chemistry, 1983, 4(2):187-217.	
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	C7	CORNELL et al., "A Second Generation Force Field for the Simulation of Proteins, Nucleic Acids, and Organic Molecules," J. Am. Chem. Soc., 1995, 117:5179-5197.	
	C8	DAHIYAT et al., "Protein Design Automation," Protein Science, 1995, 4(2):83.	
	C9	DAHIYAT et al., "Automated design of the surface positions of protein helices," Protein Science, 1997, 6:1333-1337.	
	C10	DAHIYAT et al., "De Novo Protein Design: Fully Automated Sequence Selection," Science, 1997, 278:82-87.	
	C11	DAHIYAT et al., "First Fully Automatic Design of a Protein Achieved by Caltech Scientists," Caltech Media Relations Press Release, 1997, pp.1-2.	
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	C13	DAHIYAT et al., "Protein design automation," Caltech Biology Annual Report, 1995, p.172.	
	C14	DAHIYAT et al., "Protein design automation," Protein Science, 1996, 5:895-903.	
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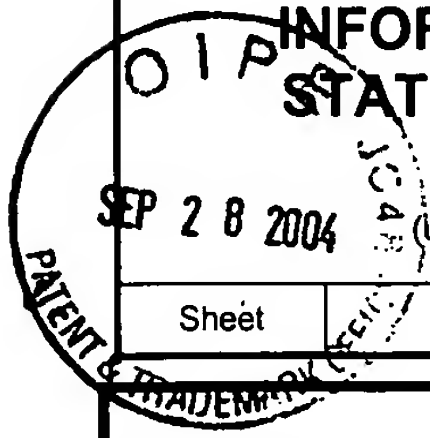
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Substitute for form 1449A/PTO (Modified)				Complete if Known	
INFORMATION DISCLOSURE STATEMENT BY APPLICANT (use as many sheets as necessary)				Application Number	10/665,307
				Filing Date	September 18, 2003
				First Named Inventor	DAHIYAT, Bassil I.
				Art Unit	1639
				Examiner Name	Wessendorf, Teresa D.
Sheet	3	of	5	Attorney Docket Number	A-67229-13



NON PATENT LITERATURE DOCUMENTS

Examiner Initials*	Cite No.	Include name of the author (in CAPITAL LETTERS), title of the article (when appropriate), title of the item (book, magazine, journal, serial, symposium, catalog, etc.), date, page(s), volume-issue number(s), publisher, city and/or country where published.	T ⁶
	C22	DESMET et al., The "Dead-End Elimination" Theorem: A New Approach to the Side-Chain Packing Problem," The Protein Folding Problem and Tertiary Structure Prediction, 1994, Ch. 10:1-49.	
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	C33	HELLINGA, "Rational protein design: Combining theory and experiment," Proceedings of the National Academy of Sciences, USA, 1997, 94:10015-10017.	
	C34	HOLMES, "First-ever designer protein fits like a glove," New Scientist, 1997, pp.1-2.	
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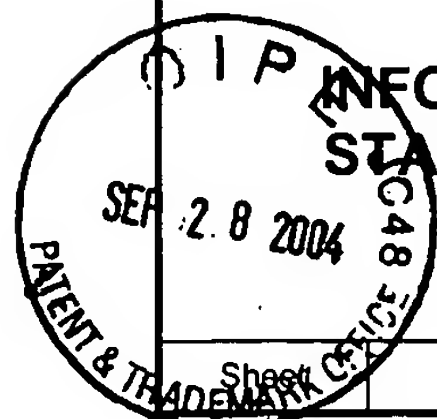
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		Filing Date	September 18, 2003
		First Named Inventor	DAHIYAT, Bassil I.
		Art Unit	1639
		Examiner Name	Wessendorf, Teresa D.
Sheet 4 of 5	Attorney Docket Number	A-67229-13	

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	C41	LASTERS et al., "Dead-End Based Modeling Tools to Explore the Sequence Space that is Compatible with a Given Scaffold," Journal of Protein Chemistry, 1997, 16(5):449-452.	
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	C43	LAZAR et al., "De novo design of the hydrophobic core of ubiquitin," Protein Science, 1997, 6:1167-1178.	
	C44	LEE et al., "Accurate prediction of the stability and activity effects of site-directed mutagenesis on a protein core," Nature, 1991, 352:448-451.	
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	C47	MAYO et al., "DREIDING: A Generic Force Field for Molecular Simulations," J. Phys. Chem., 1990, 94:8897-8909.	
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	C49	MUNOZ et al., "Analysis of the effect of local interactions on a protein stability," Folding & Design, 1996, 1(3):167-178.	
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	C51	MUNOZ et al., "Intrinsic secondary structure propensities of the amino acids, using statistical phi-psi matrices: comparison with experimental scales," Proteins, 1994, 20(4):301-11.	
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	C53	PADMANABHAN et al., "Relative helix-forming tendencies of nonpolar amino acids," Nature, 1990, 344:268-270.	
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	C55	RAPPE et al., "Charge Equilibration for Molecular Dynamics Simulations," J. Phys. Chem., 1991, 95:3358-3363.	
	C56	REGAN, "Helix is a helix is a helix?" Proceedings of the National Academy of Sciences USA, 1997, 94:2796-2797.	
	C57	SMITH et al., "Guidelines for Protein Design: The Energetics of β Sheet Side Chain Interactions," Science, 1995, 270:980-982.	
	C58	STICKLE et al., "Hydrogen Bonding in Globular Proteins," J. Mol. Biol., 1992, 220:1143-1159.	
	C59	SUN et al., "Designing amino acid sequences to fold with good hydrophobic cores," Protein Engineering, 1995, 8(12):1205-1213.	
	C60	TUFFERY et al., "A New Approach to the Rapid Determination of Protein Side Chain Conformations," Journal of Biomolecular Structure & Dynamics, 1991, 8(6):1267-1289.	

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	C61	VAN GUNSTEREN et al., "Prediction of the Activity and Stability Effects of Site-directed Mutagenesis on a Protein Core," J. Mol. Biol., 1992, 227:389-395.	
	C62	VILLEGAS et al., "Stabilization of proteins by rational design of α -helix stability using helix/coil transition theory," Folding & Design, 1995, 1(1):29-34.	
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	C64	WESSON et al., "Atomic solvation parameters applied to molecular dynamics of proteins in solution," Protein Science, 1992, 1:227-235.	
	C65	WILSON et al., "Computational Method for the Design of Enzymes with Altered Substrate Specificity," J. Mol. Bio., 1991, 220:495-506.	
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